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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,196	11/12/2003	Solomon P. Wasser	WASSER1	2921

1444 7590 10/28/2004

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EXAMINER


GELLNER, JEFFREY L

ART UNIT PAPER NUMBER

3643

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/705,196	Applicant(s) WASSER ET AL. 	
	Examiner Jeffrey L. Gellner	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 14-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13 is/are rejected.
- 7) ☒ Claim(s) 9-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12 November 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Acknowledgement is made of Applicant's IDS received 12 November 2003.

#### *Election/Restrictions*

Applicant's election with traverse of Invention I (claims 1-13) in the reply filed on 1 October 2004 is acknowledged. The traversal is on the ground(s) that: (1) as for Inventions I and II, the method's independent claim recites the growing of mushrooms ““on a sterilized substrate containing olive oil waste as the nutrient”” (Reply page 2 1<sup>st</sup> complete para.); (2) as for Inventions I and III, claim 1 recites *Lentinus edodes* which the genus/species of the shiitake strain, Ile-1 (Reply page 3 1<sup>st</sup> complete para.); (3) as for Inventions II and III, the method of Invention II make the strain of Invention III produce significantly higher yields (Reply page 3 2<sup>nd</sup> complete para.); and, the substrate of Invention I is not an apparatus (Reply page 3 3<sup>rd</sup> complete para.). This is not found persuasive because: as to argument (1), the method, for purposes of restriction, is considered to be the method of production of edible and medicinal shiitake mushrooms which can be achieved by a different process than claimed; as to argument (2), although *Lentinus edodes* is cited it is not positively claimed in claim 1 and, therefore, in claim 1 is given little, or no, patentable weight; as to argument (3), the strain of Invention III is not recited in claim 14 so the strain is not needed for the method to work, i.e., the strain and method are patentably distinct; as to argument (4), Examiner considers the composition of Invention I to be an apparatus in this context.

The requirement is still deemed proper and is therefore made FINAL. Claims 14-31 are withdrawn from examination. Applicant is reminded that before any claims can pass to issue claims 14-31 must be cancelled.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 13 are rejected under 35 U.S.C. §102(b) as being anticipated by Kirch (ES 2007071 A; abstract in English only).

As to Claims 1 and 13, Kirch discloses a substrate comprising olive oil waste (“olive residues” of title) as the nutrient for growth of edible and medicinal shiitake mushrooms (*Lentinus edodes*) (see abstract and that olive oil waste is capable of growing any strain of *Lentinus edodes*).

***Claim Rejections - 35 USC §103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3643

Claims 2-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kirch (ES 2007071 A; abstract in English only) in view of Joo et al. (HU 209034 B).

As to Claims 2-8, the limitations of Claim 1 are disclosed as described above. Not disclosed is the substrate further including vegetative waste, wheat straw, and a mineral fertilizer, gypsum. Joo et al., however, discloses a mushroom substrate with wheat straw (abstract written in English) and gypsum (abstract written in English). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the substrate of Kirch by adding wheat straw and gypsum as disclosed by Joo et al. so as to make the substrate more nutritionally complete so as to increase mushroom growth.

#### ***Allowable Subject Matter***

Claims 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

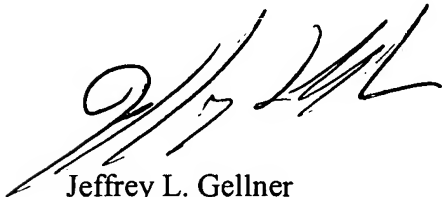
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carroll Jr. et al. disclose in the prior art a mushroom substrate with oil meals used on many mushroom species. Tamiya discloses in the prior art a mushroom substrate with straw and oil cake. Pompei et al. (title only) disclose in the prior art the use of olive milling waste water for mushroom culture.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey L. Gellner whose phone number is 703.305.0053. The Examiner can normally be reached Monday through Thursday from 8:30 am to 4:00 pm. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Peter Poon, can be reached at 703.308.2574. The official fax telephone number for the Technology Center where this application or proceeding is assigned is 703.872.9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

A handwritten signature in black ink, appearing to read 'J. L. Gellner', is written over a horizontal line.

Jeffrey L. Gellner  
Primary Examiner